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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202			EXAMINER AHMED, AFFAF	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 08/11/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/091,612	TAGSETH ET AL.	
	Examiner	Art Unit	
	AFAF AHMED	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 05/04/2011.
2. Claims 51, 69 and 70 have been amended.
3. Claims 71-72 have been added.
4. Claims 1- 50, 60 and 66 have been canceled.
5. Claims 51-59, 61-65 and 67-72 are currently pending and have been examined.

Response to Applicant's Arguments

6. Applicant's amendments and arguments filed on 05/04/2011 have been fully considered and discussed in the next section. Applicant is reminded that the claims must be given its broadest, reasonable interpretation.

With regard to claims 51, 69 and 70:

- Applicant argues that “*Brody does not disclose or contemplate offers made up of more than one component, (e.g. offer content and offer context, separately contained from one another.*”

Examiner respectfully disagrees. It appears that Applicant has misinterpreted the Office action rejection, which clearly indicates claims 51, 69 and 70 are rejected under the combination of Brody in view of Ehrling. Ehrling in at least column 5, lines 39-45 and column 6, lines (8-17 and 26-45) discloses identifying, by the computer-based system a separately contained incentive offer context based on the attributes of the user profile, wherein the plurality of separately contained offer contents are stored independently from the separately contained incentive offer context.

- Applicant argues that “*Brody also fails to disclose or contemplate creating a customized offer summaries based on corresponding customized offers that are displayed in the offer context identified for a particular user.*”

Examiner respectfully disagrees. As per Applicant specification discloses “ FIG. 2 illustrates an exemplary centralized repository 110. Each of the offers 160 in the repository 110 may include an offer summary 162 and a set of offer details 164 paragraph 28.” The specification does not specify what an offer summary is, thus, given the broadest interpretation a summary of an offer could be a link to an offer, a pre approved offer of particular merchant, a category of an offer, an Id of merchant, who offer the offer and/ or any information lead to the actual offer.

Thus, Brody in at least paragraph 11 discloses "According to another embodiment of the present invention, a method of providing one or more pre-approved offers to a consumer based on credit-related information of the consumer is disclosed. The method of providing one or more pre-approved offers can include creating an account with the consumer, transmitting to a credit bureau an inquiry for credit history data relating to the consumer, receiving credit history data on the consumer in response to the inquiry, and selecting a pre-approved offer (summary of an offer) from a plurality of offers from multiple merchants based at least partially on the credit history data of the consumer. The method can further include presenting the offer to the consumer, where the offer is for establishing a credit-based account with a merchant.. Brody also in at least paragraph 75 discloses Pre-approved offers may be listed or presented in a number of different manners. Most preferably, the offers are displayed using a web-based representation of the pre-approved offers (summaries of an offer). According to yet another aspect of the invention, the offers may be rated independently by the system of the present invention according to an algorithm which analyzes the offer or offers that best suit the individual consumer based upon one or more of the consumer's credit profile. For example, where the consumer's credit profile identifies that the consumer owns a Visa credit card, and where the consumer has selected to receive pre-approved offers from credit card merchants, the system may present Mastercard, American Express or Discover offers in a more prominent manner than Visa offers, due to the fact that the consumer already has a Visa card. Furthermore, Brody in at least paragraph 77, discloses Each pre-approved (summary of an offer) provided to the consumer can include selections (summaries) that enable the consumer to accept the pre-approved (summary of an offer) offer or find out more about the pre-approved offer.

- Applicant argues that "*like Brody , Ehring fails to discloses or contemplate creating a customized summaries based on corresponding customized offers that are displayed in the offer context identified for a particular user. More specifically like Brody, Ehring does not disclose a system that displays customized selectable offer summaries in a context corresponding to each of the actual offers presented to a user.*"

Examiner respectfully disagrees. As indicated above, the above newly added limitation is addressed under Brody.

Claim Rejections - 35 USC § 112

7. Claims 51, 69 and 70-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Claims 51, 69 and 70 recite the limitation of:

- *creating by the computer –based system a plurality of customized offer summaries based on the corresponding modified separately contained incentive offer contents.*

The specification teaches “FIG. 2 illustrates an exemplary centralized repository 110. Each of the offers 160 in the repository 110 may include an offer summary 162 and a set of offer details 164 , (paragraph 28). The specification also teaches “A maintenance engine is adapted to respond to requests to create, modify, and delete offer summaries and offer details stored within the centralized offer repository (paragraph 13).” The specification does not teach *creating by the computer –based system a plurality of customized offer summaries based on the corresponding modified separately contained incentive offer contents*. Nor does the specification teaches *associating, by the computer based system one or more of the plurality of customized offer summaries with one or more of the corresponding plurality of user offers and displaying, by the computer based system the plurality of customized offer summaries within the identified incentive offer context.*

9. Claim 71 recites the limitation of:

- *wherein a user is routed to a merchant providing the selected user offer in response to the user offer being of a first type.* The specification teaches “The system also streamlines business processes across the enterprise for online offers by consolidating offeree communications by directing them to a single online offer source, establishing consistent branding of online offers across the company's applications and eliminating merchant confusion as individual online offer programs are sold-in to merchants with distinct/unique pricing implications and features (paragraph 38).” The specification does not teach “*wherein a user is routed to a merchant providing the selected user offer in response to the user offer being of a first type*”.

10. Claims 51, 69 and 70-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 51, 69 and 70 recite the limitations of :

- *creating by the computer –based system a plurality of customized offer summaries based on the corresponding modified separately contained incentive offer contents.* It is unclear what Applicant is referring to by *creating by the computer –based system a plurality of customized offer summaries based on the corresponding modified separately contained incentive offer contents?* Does Applicant means that each and every offer has more than one summary or does Applicant means that one offer is being modified more than once as a result such offer will have more than summary. Appropriate correction and/ or clarification is required.
- *associating, by the computer based system one or more of the plurality of customized offer summaries with one or more of the corresponding plurality of user offers.* It is unclear what

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Applicant is referring to by associating, by the computer based system one or more of the plurality of customized offer summaries with one or more of the corresponding plurality of user offers? Does Applicant means that each and every offer has more than one summary or does Applicant means that one offer is being modified more than once as a result such offer will have more than summary. Furthermore, it is unclear if each user has more than one user offer. Appropriate correction and/ or clarification is required.

- *displaying, by the computer based system the plurality of customized offer summaries within the identified incentive offer context;* It is unclear what Applicant is referring to by displaying, by the computer based system the plurality of customized offer summaries within the identified incentive offer context? Does Applicant means that each and every offer has more than one summary or does Applicant means that one offer is being modified more than once as a result such offer will have more than summary. Furthermore, it is unclear *what applicant is referring to by displaying, by the computer based system the plurality of customized offer summaries within the identified incentive offer context*. Appropriate correction and/ or clarification is required.

12. Claim 71 recites the limitation of:

- *Wherein a user is routed to a merchant providing the selected user offer in response to the user offer being of a first type.* It is unclear what Applicant is referring to by *wherein a user is routed to a merchant providing the selected user offer in response to the user offer being of a first type*. Appropriate correction and/ or clarification is required.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 51-59, 61-64, 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody, US Pub No: 2002/0077964 A1 in view Ehrling et al, US Patent No: 7,558,748 B2.

Claims 51, 69 and 70:

Brody discloses:

- *receiving, by a computer-based system for customizing an incentive offers, a user formulated search, wherein the user has an associated user profile* (see at least paragraphs 41 and 34);
- *analyzing, by the computer-based system, attributes of a user profile* (see at least paragraphs 34,38 and 44);
- *identifying, by the computer-based system a, plurality of incentive offer contents based on the user formulated search and the attribute of the user profile* (see at least paragraphs 14-15 and 41);
- *filtering by the computer-based system, each summary of the plurality of incentive offer contents from a centralized repository of incentive offers contents, based on the user formulated search and the attributes of the user profile, wherein each summary corresponds to a customized offer for a user* (see at least paragraphs 14, 41, 54 and fig 2 with the associated text);
- *creating by the computer –based system a plurality of customized offer summaries based on the corresponding modified incentive offer contents* (see at least paragraph 11) ;
- *associating, by the computer based system one or more of the plurality of customized offer summaries with one or more of the corresponding plurality of user offers and displaying, by the computer based system the plurality of customized offer summaries within the identified incentive offer context* (see at least paragraphs 11, 75 and 77);
- *displaying, by the computer based the user offer in response to a selection of the corresponding customized offer summary* (see at least paragraph 11, 14 and 41);

Brody does not specifically disclose, but Ehrling however discloses:

- *modifying by the computer-based system, at least portion of the plurality of separately contained incentive offer contents based on the attributes of the user profile* (see at least column 17, lines 46-57, column 19, lines 33-67);
- *identifying, by the computer–based system a separately contained incentive offer context based on the attributes of the user profile, wherein the plurality of separately contained offer contents are stored independently from the separately*

contained incentive offer context (see at least column 5, lines 39-45, column 6, lines (8-17 and 26-45), and fig 2 with the associated text);

- *combining, by the computer-based system, each separately customized offer with the incentive offer context to create a plurality of user offers and displaying, by the computer-based system, the incentive offer to the user* (see at least column 6, lines 26-45, column 10, lines 60-67 and column 11, lines 1-36);

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system and method for providing consumers pre-approved offers from a selected group of merchants the ability to separately store content and context of offers as taught by Ehring, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination (providing an infrastructure system that is used by advertisers to create their own unique dynamic rules (context) of a plurality of offers (Ehring, column 7, lines 40-42) were predictable.

Claim 52:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

- *maintaining, by the computer-based system, the plurality of incentive offer contents, wherein the plurality of incentive offer contents are at least one of created, modified, or deleted within the centralized repository in response to an administrator request* (see at least paragraphs 44 and 47);

Claims 53 and 54:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

- *authenticating, by the computer-based system, the merchant in response to a request by the merchant to submit an incentive offer to the centralized repository;*
- *limiting access to the merchant to the centralized repository;*

See at least paragraphs 33 and 72;

Claim 55:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

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- *tracking, by the computer-based system, a number of times the incentive offer has been displayed to the user* (see at least paragraph 44);

Claim 56:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

- *tracking, by the computer-based system, a number of times a class of the incentive offers has been displayed to the user* (see at least paragraphs 44 and 69-70);

Claim 57:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

- *wherein the incentive offer is displayed via a webpage* (see at least paragraphs 55 and 69);

Claims 58 and 59:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

- *generating, by the computer-based system, a report describing the incentive offers contained within the centralized repository;*
- *wherein the report describes a number of times the incentive offer has been retrieved;*

See at least paragraph 44 and fig 2 with the associated text;

Claim 61:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer details include at least of an offer identifier, an offer promotion identifier, an offer type, or a definition of offer terms* (see at least paragraph 69);

Claim 62:

The combination of Brody/ Ehring discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further identifying at least one of a merchant name, a target merchant, a target good, or a target service* (see at least paragraphs 54 and 68);

Claim 63:

The combination of Brody/ Ehrling discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further includes at least one of merchant demographic, merchant type, or geographic location identifier* (see at least paragraphs 52 and 78);

Claim 64:

The combination of Brody/ Ehrling discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further includes at least one of offer category identifier, a target product, or service identifier* (see at least paragraph 68);

Claim 65:

The combination of Brody/ Ehrling discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further includes at least one of a description of terms of the offer, a term length for displaying the offer, a keyword, SKU/UPC information, or customer service telephone number* (see at least paragraph 41);

Claim 67:

The combination of Brody/ Ehrling discloses the limitations as shown above.

Brody further teaches:

- *wherein the centralized repository is maintained by an issuer of the user transaction account* (see at least paragraphs 41, 44 and fig 2 with the associated text);

Claim 68:

The combination of Brody/ Ehrling discloses the limitations as shown above.

Brody further teaches:

- *receiving, by the computer-based system, an acceptance of the incentive offer from the user* (see at least paragraphs 16 and 42);

Claim 71:

The combination of Brody/ Ehrling discloses the limitations as shown above.

Brody further teaches:

- *wherein a user is routed to a merchant providing the selected user offer in response to the user offer being of a first type* (see at least paragraph 42);

Claim 72:

The combination of Brody/ Ehrling discloses the limitations as shown above.

Brody further teaches:

- *wherein the attributes of the user profile include user creditworthiness, user demographic information and user spend data* (see at least paragraph 34);

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX Months from the mailing date of this final.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at

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866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

07/18/2011

/Yehdega Retta/
Primary Examiner, Art Unit 3622